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PATENT
Customer No. 22,852
Attorney Docket No. 96001-0151

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Barclay SAUL et al.) Confirmation No. 8194
Application No.: 09/988,215) Group Art Unit: 3644
Filed: November 19, 2001) Examiner: Stephen A. Holzen
For: SYSTEM AND METHOD FOR)
HOSTING A VIRTUAL GALLERY)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

RESPONSE

Applicants hereby submit this response to the Office Action mailed September 30, 2003 (hereinafter "the Office Action"), the period for response for which extends through December 30, 2003. Claims 1-4 are currently under consideration. Claims 1 and 3 are the only independent claims.

In the Office Action, the Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over LeRoy et al. (U.S. Patent No. 5,970,474, hereinafter "LeRoy et al.") in view of Robinson et al. (U.S. Patent Appl. Publication No. 2002/0113820 A1, hereinafter "Robinson et al."). The Examiner further rejected claims 1 and 3 under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to point out and particularly claim the subject matter which Applicants

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

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regard as the invention. In this regard, the Examiner alleged that the “term ‘virtual size’ is a relative term, which renders the claim indefinite” (Office Action, p. 4).

Applicants respectfully traverses the Examiner’s rejection of pending claims 1-4 for the reasons provided below. Accordingly, Applicants submit that pending claims 1-4 are in allowable form.

The Examiner’s rejection of claims 1-4 under 35 U.S.C. § 103(a)

With respect to pending claims 1 and 3, the Examiner alleges that LeRoy et al. discloses “an environment (Col. 5 lines 47-51)” (Office Action, p. 2). Applicants respectfully traverse this characterization of LeRoy et al. Applicants respectfully direct the Examiner’s attention to at least FIGS. 7, 8, 9, 11, 13, and 14, and the discussion beginning at, for example, page 10/line 18 and continuing through page 13/line 3 of the as-filed specification where “gallery environment 715” is disclosed as an exemplary environment. The disclosed exemplary environment includes a floor region 710, a wall region 705, etc. The discussion at col. 5/lines 47-51 of LeRoy et al., alleged by the Examiner to disclose the recite “environment” simply states:

Various types of registry input devices and/or registry retrieval devices can be utilized to communicate with the in-store processors and host computer in accordance with the present invention. For example, separate computer stations can be provided for each device rather than combining the features in a single gift registry kiosk. In addition, a registrant may be able to enroll at home over a public access system such as the Internet, and purchasing customers can retrieve updated registry lists and make purchases with credit cards at home over such a public access system.

Applicants respectfully submit that one skilled in the art should appreciate that the disclosure of LeRoy et al. is devoid of any “environment” as claimed in pending claims 1-4.

Moreover, the Examiner alleges, and Applicants agree, that LeRoy et al. fails to disclose “where each of the items is characterized by at least a virtual size and items are graphically illustrated by a two-dimensional and a virtual reality representation.” (Office Action, p. 3). In this regard, the Examiner alleges that Robinson et al.

teaches that it is well known in the art to use two dimensional and 3 dimensional representations. (see ¶s 0031 and 0036). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the 2D and virtual reality representations of Robinson into the concept of LeRoy for increasing the user friendliness of said concept.

(Office Action, p. 3, emphasis added.)

Applicants respectfully traverse the Examiner’s characterization of the teachings of Robinson et al. and further, Applicants respectfully traverse any alleged motivation to combine Robinson et al. and LeRoy et al.

To begin with, Applicants’ submit that one skilled in the art would appreciate that Robinson et al. does not teach the use of both a two-dimensional representation and a virtual reality representation as claimed. Rather, Robinson et al., at most, teaches the advantages of a 3D representation in place of a two-dimensional representation. Accordingly, Applicants submit, it is improper for the Examiner to alter the disclosure of Robinson et al. in a manner that fundamentally conflicts with its teachings when combining with LeRoy et al. in order to support a rejection under 35 U.S.C. § 103(a). In this regard, at least, Applicants respectfully submit that Robinson et al. teaches away from the invention as claimed in pending claims 1-4.

Moreover, Applicants respectfully submit that Robinson et al. does not anywhere disclose accounts with read-only access as claimed. Although the Examiner has relied upon LeRoy et al. for this alleged teaching, Applicants remind the Examiner that a proposed modification of a prior

art teaching cannot render the prior art unsatisfactory for its intended use (see M.P.E.P. § 2143.02 (8th ed. 2001)). In this regard, Applicants respectfully submit that any proposed combination of LeRoy et al. with Robinson et al. in order to force even a subset of the claim elements reciting “read-only access” to read on the combination, renders the teachings of Robinson et al. unsatisfactory for its intended use. Specifically, Robinson et al. repeatedly emphasizes the ability of the user to modify any and all aspects of the displayed environment, including the launching of programs (all in a 3D computer environment only). In contrast, a proposed modification of Robinson et al. instituting read-only access in both “a two-dimensional representation and a virtual reality representation,” as claimed, renders the disclosure of Robinson et al. unfit for its intended use. See, for example: (i) paragraph 0036 of Robinson et al. which discloses a furniture company website in a “3D environment” that may be fully manipulated by a customer; (ii) paragraph 0038 of Robinson et al. which discloses a toy company website in a “3D environment” that may be fully manipulated by a customer. Applicants submit that one skilled in the art should appreciate that not only is the disclosure devoid of two representations of the “gallery item and the gallery environment” as claimed, but that instituting “read-only” access renders the furniture or toy web site of Robinson et al. unfit for its intended use.

Accordingly, Applicants submit that not only does the combination of LeRoy et al. and Robinson et al. fail to disclose each and every element as claimed, Robinson et al. teaches against the presentation of a “gallery item” and a “gallery environment” in “read-only” mode in both a “two-dimensional representation” and a “virtual reality representation.” Accordingly, for

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at least these reasons, Applicants respectfully request the Examiner to withdraw the rejection of pending claims 1-4 under 35 USC § 103(a).

Further still, Applicants respectfully traverse the Examiner's alleged basis for combining Robinson et al. and LeRoy et al. as arising from an "increase[e] in the user friendliness of said concept" (Office Action, p. 3). Applicants respectfully submit that an increase in "user friendliness" as a basis for combining references LeRoy et al. and Robinson et al. constitutes impermissible hindsight. Although the Examiner is permitted a variety of rationales to combine references, such as common knowledge in the art, scientific principles, art-recognized equivalents, or legal precedent, Applicants submit that the Examiner's view that "user friendliness" would be increased through a combination of LeRoy et al. and Robinson et al. appears to be a subjective judgment of the Examiner's, and, in its present form, is impermissible as a basis for supporting a rejection under 35 U.S.C. § 103. (See, for example, M.P.E.P. § 2144 (8th ed. 2001)). In this regard, Applicants submit that the Examiner appears to be taking official notice with regard to the claim element "where the first gallery account in the read-only access mode is configured to allow access to at least two representations of the first gallery item and the gallery environment including a two-dimensional representation and a virtual reality representation." If this is the case, Applicants submit that the Examiner must provide an "affidavit" or a "reference" to support the Examiner's position. (See M.P.E.P. § 2144.03) Absent such support, the rejection of claims 1-4 under 35 U.S.C. § 103(a) should be withdrawn for at least this additional reason.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

The Examiner's rejection of claims 1 and 3 under 35 U.S.C. § 112 ¶ 2

The Examiner further alleged that the "term 'virtual size' is a relative term, which renders [claims 1 and 3] indefinite" under 35 U.S.C. § 112, ¶ 2 (Office Action, p. 4). Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 112, ¶ 2 for the reasons provided below.

The Examiner is reminded, under MPEP § 2173.02, that

[t]he examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

Applicants maintain that, among other elements, the following clause of claims 1-4 meet the threshold requirements of clarity and precision with respect to the Examiner's allegation that it is a "relative term": "where each of the gallery items is characterized by at least a virtual size." Applicants respectfully direct the Examiner to the discussion in the as-filed specification at page 11/lines 17-20 where "height information 1025" and "width information 1020" are associated with an item added to "gallery environment 715" (see also FIG. 10). Moreover, Applicants remind the Examiner that the conventional meaning of term "virtual" in computer science is: "Created, simulated, or carried on by means of a computer or computer network" (*American Heritage Dictionary, Fourth Edition*, 2000, p. 1922) and the conventional meaning of

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“size” is “physical dimensions, proportions, magnitude, or extent of an object” (*American Heritage Dictionary, Fourth Edition*, 2000, p. 1629, emphasis added). Applicants maintain that the Examiner has analyzed claims 1-4 in a vacuum, rather than in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

(see MPEP § 2173.02.) In this regard, Applicants submit that the terms “virtual reality representation” and “gallery environment” are also used in the claim, and may also assist in informing one skilled in the art as to the clarity and precision of the term “virtual size.”

Although the Examiner has not given the adjective “gallery” any patentable weight, Applicants submit that the Examiner has divorced claims 1 and 3 from all context in concluding that the term “virtual size” is indefinite. The Examiner, in addition, is reminded that:

[b]readth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

(see MPEP § 2173.04.) For the above reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 3 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention under 35 U.S.C. § 112, ¶ 2.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
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Conclusion

Accordingly, Applicants submit that claims 1-4 are in allowable form and respectfully request the timely allowance of all pending claims. In the event that there are questions regarding this response, or if the next action on the merits is not an allowance of all pending claims, Applicants respectfully request an interview with the Examiner

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 30, 2003

By: 

James J. Boyle

Reg. No. 46,570

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com